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EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 10/17/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/037,106

Applicant(s)

WOLLEB ET AL.

Examiner

Martin J Angebrannt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/365,471.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to metallocenyl phthalocyanine compounds, classified in class 540, subclass 140.
  - II. Claim 7, drawn to process of making metallocenyl phthalocyanine compounds using esterification, classified in class 556, subclass 143.
  - III. Claims 8-11, drawn to optical recording media and methods of use, classified in class 430, subclass 270.16.
2. Inventions group II and group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the compounds may be made by attaching the cyclopentadienyl moieties to the phenyl groups before forming the phthalocyanine ring.
3. Inventions groups II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the process of use of the optical recording media and/or the optical recording media themselves are unrelated to the process of making the metallocenyl phthalocyanine dye.
4. Groups I and III are related and would be examiner together as the dyes does not undergo any change when forming the optical recording medium.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with David Crichton (37,300) on October 16, 2002 a provisional election was made with traverse to prosecute the invention of groups I and III, claims 1-6 and 8-11. Affirmation of this election must be made by applicant in replying to this Office action. Claim 8 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9 **The application should be amended to indicate the parent application and that it is now a US patent. The examiner notes that the parent application contains a translation of the priority document received on 7/30/2002 and therefore the effective filing date is 11/8/1998.**

10 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11 Claims 1-6 and 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, at line 4, please replace "atoms or atom groups" with - - members- - .

In claims 8 and 11, these processes have no steps and are therefore improper.

12 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14 Claims 1,2,8,9 and 11 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) .

See compound shown in the lower portion of Scheme 1, on page 1715. The octylester linkage uses the carbonyl, oxygen and methylene moieties listed in claim 1. The spectroscopic properties are disclosed including the absorption in the 600-800 nm region in figure 1.

If the methods claims recited some steps then this would obviate the exposure to UV/VIS light shown in figure 2

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15      Claims 1,2 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995), in view of Kimura et al. EP 0811506 and Itoh et al. '067.

Kimura et al. EP 0811506 teaches the formation of optical recording media in example1, including the measurement of absorption properties. Example 2 includes the reflective layer and protective layer in the structure. The addition of the moieties including the ferrocyanine moieties increases the light resistance of the media. (page 7). The use of these with semiconductor lasers is disclosed.

Itoh et al. '067 teaches that desirable optical recording media using phthalocyanine dyes absorb in the 700-900 nm range and are useful with semiconductor lasers. (2/34-45). The use of 780 nm semiconductor lasers is disclosed at least in examples 1 and 2. The use of these in liquid crystal matrices is also disclosed.

Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) does not disclose optical recording media with structure beyond a simple film coated on a glass slide. It would have been obvious to use the metallocenyl phthalocyanine dye disclosed by Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) in place of the metallocenyl phthalocyanine dye used in the examples of Kimura et al. EP 0811506 with a reasonable expectation of gaining the advantages of improved stability and light resistance disclosed therein and would have been further moved to do so based upon the absorption properties disclosed by Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) which are within the range disclosed as desirable by Itoh et al. '067, who also establishes the linkage between liquid crystal materials and optical recording media.

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16 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17 Claims 1-6 and 8-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,399,768.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims overlap with those of the issued application.

**The examiner notes that amending claims 1-6 to obviate the prior art should be done without creating the statutory double patenting situation.**


18 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 703-308-4397.

The examiner can normally be reached on Available Mondays-Thursday and alternative Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Martin J Angebranndt  
Primary Examiner  
Art Unit 1756

October 16, 2002